



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/489,134	01/21/2000	William J. Baer	STL000012US1	5405

24852 7590 03/14/2002

INTERNATIONAL BUSINESS MACHINES CORP
IP LAW
555 BAILEY AVENUE, J46/G4
SAN JOSE, CA 95141

EXAMINER

PHAM, HUNG Q

ART UNIT PAPER NUMBER

2172

DATE MAILED: 03/14/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/489,134

Applicant(s)

BAER ET AL.

Examiner

HUNG Q PHAM

Art Unit

2172

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-90 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-90 is/are rejected:
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.

- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

2. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. **Claims 1, 6, 8-13, 15-18, 20-23, 27, 30-31, 36, 38-43, 45-48, 50-53, 57, 60-61, 66, 68-73, 75-78, 80-83, 87 and 90 are rejected under 35 U.S.C. 102(e) as being anticipated by Bagshaw [USP 6,308,176].**

Regarding to claims 1, 31, and 61, Bagshaw teaches a method, a program storage device readable by a machine and a system for creating a compilation of content stored in a database that stores the processed source files (Fig. 2B). The Bagshaw method comprises: presenting a plurality of selectable objects to a user, each object associated with a subset of the collection of content; in response to selection by a user of one or more of said objects, creating a compilation of the content associated with each selected object (Fig. 23, Col. 11, lines 64-67 and Col. 12, lines 1-3).

Regarding to claims 6, 36, and 66, Bagshaw teaches all the claimed subject matters as discussed in claims 1, 31, and 61, Bagshaw further discloses the collection of content comprises hierarchically related data (Fig. 6, Col. 6, lines 46-51).

Regarding to claims 8, 38, and 68, Bagshaw teaches all the claimed subject matters as discussed in claims 1, 31, and 61, Bagshaw further discloses: displaying to the user the selected objects in a predetermined order such that the user may rearrange the order of the selected objects as desired through a user interface (Fig. 21, **Sort** and **Ascending box**, Fig. 23).

Regarding to claims 9, 39, and 69, Bagshaw teaches all the claimed subject matters as discussed in claims 1, 31, and 61, Bagshaw further discloses: the step of creating a compilation further comprises the steps of: defining a maximum amount of

Art Unit: 2172

allowable content per volume of content; creating a plurality of volumes of content from the selected content based upon the defined maximum (Col. 9, lines 15-23).

Regarding to claims 10, 40, and 70, Bagshaw teaches all the claimed subject matters as discussed in claims 9, 39, and 69, Bagshaw further discloses: displaying to the user the selected objects contained in each volume such that the user may selectably move an object from a first to a second of the volumes (Fig. 6, Col. 6, lines 46-63).

Regarding to claims 11, 41, and 71, Bagshaw teaches all the claimed subject matters as discussed in claims 1, 31, and 61, Bagshaw further discloses: receiving a content input by a user, and creating a selectable object from the content (Fig. 2B, Col. 5 and Fig. 23).

Regarding to claims 12, 42, and 72, Bagshaw teaches all the claimed subject matters as discussed in claims 1, 31, and 61, Bagshaw further discloses: the user may concurrently create a plurality of compilation (Col. 11, lines 26-34).

Regarding to claims 13, 43, and 73, Bagshaw teaches all the claimed subject matters as discussed in claims 1, 31, and 61, Bagshaw discloses: after creation of the compilation, presenting the compilation to a user for modification (Fig. 5).

Regarding to claims 15, 45, and 75, Bagshaw teaches all the claimed subject matters as discussed in claims 13, 43, and 73, Bagshaw further discloses: the user may select an object for removal from the compilation (Fig. 6, **delete button X** in tool bar).

Regarding to claims 16, 46, and 76, Bagshaw teaches all the claimed subject matters as discussed in claims 1, 31 and 61, Bagshaw and further discloses: the user may select to clear the compilation (Fig. 6, **delete button X** in tool bar).

Regarding to claims 17, 47, and 77, Bagshaw teaches all the claimed subject matters as discussed in claims 1, 31, and 61, Bagshaw further discloses: the user may select to undo an operation affecting the compilation (Fig. 6, **undo button** in tool bar).

Regarding to claims 18, 48, and 78, Bagshaw teaches all the claimed subject matters as discussed in claims 1, 31, and 61, Bagshaw further discloses: after creation of the compilation, submitting the compilation to an approval process (Fig. 5, steps **506-507**).

Regarding to claims 20, 50, and 80, Bagshaw teaches all the claimed subject matters as discussed in claims 1, 31, and 61, Bagshaw further discloses: the presenting step further comprises the step of presenting all of the content comprising the collection of content to the user as a plurality of selectable objects (Fig. 23, Col. 11, line 64-Col. 12, line 3).

Regarding to claims 21, 51, and 81, Bagshaw teaches all the claimed subject matters as discussed in claims 1, 31, and 61, Bagshaw further discloses: the presenting step further comprises the step of presenting less than all of the content comprising the collection of content to the user as a plurality of selectable objects (Fig. 23, Col. 11, line 64-Col. 12, line 3).

Regarding to claims 22, 52, and 82, Bagshaw teaches all the claimed subject matters as discussed in claims 21, 51, and 81, Bagshaw further discloses: the step of partitioning the collection of content into a plurality of categories, and presenting all content objects belonging to a category to a user (Fig. 23, Col. 11, line 64-Col. 12, line 3).

Regarding to claims 23, 53, and 83, Bagshaw teaches all the claimed subject matters as discussed in claims 1, 31, and 61, Bagshaw further discloses the presenting step further comprises the steps of: receiving search criteria input by the user; determining which of the subsets of the collection of content satisfy the search criteria; and presenting to the user a plurality of selectable objects corresponding to the subsets of content satisfying the search criteria (Fig. 23, Col. 11, lines 35-66).

Regarding to claims 27, 57, and 87, Bagshaw teaches all the claimed subject matters as discussed in claims 1, 31, and 61, Bagshaw further discloses: the selectable

Art Unit: 2172

objects further comprise titles of their associated subsets of content (Fig. 23, Col. 9, lines 24-29).

Regarding to claims 30, 60, and 90, Bagshaw teaches a method for creating a compilation from a plurality of content objects stored in a data repository (Fig. 2B), each content object comprising a plurality of hierarchically related content entities (Fig. 6, Col. 6, lines 46-51), comprising the steps of: in response to selection of ones of the hierarchically related elements to include in a compilation, creating a compilation from the selected content entities (Fig. 23, Col. 11, lines 64-67 and Col. 12, lines 1-3).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised

of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 2-3, 7, 14, 24-26, 28-29, 32-33, 37, 44, 54-56, 58-59, 62-63, 67, 74, 84-86 and 88-89 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bagshaw [USP 6,308,176].

Regarding to claims 2, 32, and 62, Bagshaw teaches all the claimed subject matters as discussed in claims 1, 31 and 61, Bagshaw further discloses: the collection of content comprises at least one of a document (Fig. 23) but fails to teaches the collection comprises at least one of a book, an image, a collection of musical selection and a video. However, the Bagshaw method is to process large data files and data file includes all kind of documents such as electronic book, image, audio and video by default. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the Bagshaw method to include book, image, audio and video file as the content of database in order to search and retrieve all kind of information from a database.

Regarding to claims 3, 33, and 63, Bagshaw teaches all the claimed subject matters as discussed in claims 2, 32, and 62, Bagshaw further discloses: the subsets of

Art Unit: 2172

content comprise sections of a text document (Col. 9, lines 8-29). Bagshaw fails to teach: subsets of content comprise one of a chapter. However, Bagshaw discloses the file may be structured with headings and sub-headings; thus, the file can be divided into a plurality of section at the start of heading, and this implies the chapters if the data file is an electronic book. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the Bagshaw method to include the chapter as a member of subset of content in order to divide the data file as a book into a plurality of chapters.

Regarding to claims 7, 37, and 67, Bagshaw teaches all the claimed subject matters as discussed in claims 6, 36, and 66, Bagshaw further discloses: the collection of content comprises at least one of a document (Fig. 23), the subsets of content comprise sections of a text document (Col. 9, lines 8-29). Bagshaw fails to teach: subsets of content comprise one of a chapter. However, Bagshaw discloses the file may be structured with headings and sub-headings; thus, the file can be divided into a plurality of section at the start of heading, and this implies the chapters if the data file is an electronic book. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the Bagshaw method to include the chapter as a member of subset of content in order to divide the data file as a book into a plurality of chapters.

Regarding to claims 14, 44, and 74, Bagshaw teaches all the claimed subject matters as discussed in claims 13, 43, and 73, Bagshaw fails to disclose the step of creating a copy of the compilation, applying changes input by a user to the copy, and creating a new compilation therefrom. However, Bagshaw teaches an existing file can be modified by loading the file to the OTL editor and after the step of modifying, the modified file will be saved (Fig. 5). This implies the step of creating a copy of the compilation, applying changes input by a user to the copy, and creating a new compilation. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the Bagshaw method to include the step of creating a copy of the compilation to apply changes and creating a new compilation in order to modify an existing file in the database.

Regarding to claims 24, 54, and 84, Bagshaw teaches all the claimed subject matters as discussed in claims 1, 31, and 61, Bagshaw fails to disclose: at least one of the subsets of content is associated with one or more prerequisite subsets of content and upon selection by the user of a selectable object associated with the at least one subset, also including the associated prerequisite subsets of content in the created compilation. However, as in Fig. 21, data files are categorized into market sector, location, company name, publisher, publication date and scope (Col. 3, lines 57-60), Fig. 23 is the result of a search within the market sector and is sorted by publication date, this indicates market sector is a subset of content and this subset of content is associated with publication date as a prerequisite subset. The user can select a record

for displaying the document within the market sector that meet the publication date requirement (Fig. 23). This implies the step of upon selection by the user of a selectable object associated with the at least one subset, also including the associated prerequisite subsets of content in the created compilation. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the Bagshaw method to include the step of selection by the user of a selectable object associated with the at least one subset, also including the associated prerequisite subsets of content in order to search for information that relates to several categories.

Regarding to claims 25, 55, and 85, Bagshaw teaches all the claimed subject matters as discussed in claims 1, 31, and 61, Bagshaw fails to disclose: a selectable object further comprises one of a container and a content entity. However, as in Fig. 23, the titles of document that return after searching indicate the containers that contain content entity as the text of the document. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the Bagshaw method to include the technique of container and content entity of a selectable object in order to store the search results.

Regarding to claims 26, 56, and 86, Bagshaw teaches all the claimed subject matters as discussed in claims 25, 55, and 55, Bagshaw fails to disclose the step of adding the selected container and any containers or content entities it contains to the compilation in response to selection of the container to add to a compilation. However,

Art Unit: 2172

Bagshaw teaches that a particular item to be selected by a user as in Fig. 23, the actual information file will be supplied to the user from the central database. This implies the step of adding the selected container and content entities to the compilation in response to selection. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the Bagshaw method to include the step of adding the selected container and content entities to the compilation in response to selection in order to supply the actual information to the user.

Regarding to claims 28, 58, and 88, Bagshaw teaches all the claimed subject matters as discussed in claims 25, 55, and 85, Bagshaw fails to disclose containers are at least one of a book, a volume, and a chapter. However, Bagshaw teaches that a large file will be divided into a plurality of sections with its heading and sub-heading and a large file may be any electronic file such as a book by default. If a large file is a book, then its heading and sub-heading will be the volume and chapter of the book. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the Bagshaw method to include container is a book, a volume and a chapter in order to divide a large file as a book into plurality of volumes and chapters.

Regarding to claims 29, 59, and 89, Bagshaw teaches all the claimed subject matters as discussed in claims 25, 55, and 85, Bagshaw further discloses: the collection of content comprises at least one of a document (Fig. 23) but fails to teaches the collection comprises at least one of books, images, albums and videos. However, the

Bagshaw method is to process large data files and data file includes all kind of documents such as electronic book, image, audio and video by default. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the Bagshaw method to include book, image, album and video file as the content of database in order to search and retrieve all kind of information from a database.

7. Claims 4-5, 34-35, and 64-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bagshaw [USP 6,308,176] in view of Guttman et al. [USP 6,173,286].

Regarding to claims 4, 34, and 64, Bagshaw teaches all the claimed subject matters as discussed in claims 1, 31, and 61, Bagshaw further discloses each selectable object is associated with a cost (Fig. 23) but fails to disclose the step of calculating a cost for the created compilation based upon the costs of the selected objects. Guttman teaches a method for optimize publication layout, which has an optimal relationship between the placement of advertisements and stories on the pages of the publication and the printing cost (Guttman, abstract). The Guttman method using UnitCostInfo and PaperUsage objects to determine the price (Guttman, Col. 6, lines 35-49). Thus, the Bagshaw selected object price can be calculated by using the unit cost and paper usage to calculate the cost of compilation. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify

the Bagshaw method to include the taught of Guttman about cost calculation in order to calculate the cost of an electronic book or document.

Regarding to claims 5, 35, and 65, Bagshaw and Guttman teaches all the claimed subject matters as discussed in claims 1, 31, and 61, Guttman further discloses the steps of determining a content count for the compilation and determining a cost for the compilation based upon the content count (Guttman, Col. 6, lines 35-49).

8. Claims 19, 49 and 79 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bagshaw [USP 6,308,176] in view of Cornelia et al. [USP 6,065,026].

Regarding to claims 19, 49, and 79, Bagshaw teaches all the claimed subject matters as discussed in claims 18, 48, and 78, Bagshaw further discloses the approval process comprises approving the compilation for publication (Fig. 5, steps **506-507**) but fails to discloses the steps of rejecting and receiving editorial comments and provide the comments to creating user. Cornelia teaches a method for maintaining a library of textual components and responding to user input to edit the document while displaying in the window (Cornelia, abstract). The Cornelia method will prompt the user to accept or reject each updated component in the document and maintaining comments associated with the component in the library (Cornelia, Col. 1, line 54-Col. 2, line 6). Thus, the Bagshaw approval process can be modified by Cornelia technique to include

Art Unit: 2172

the steps of rejecting, receiving editorial comments and providing the comments to creating user to have more option in the approval process. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the Bagshaw method to have the steps of rejecting, receiving editorial comments and providing the comments to creating user in order to optimize the approval process.

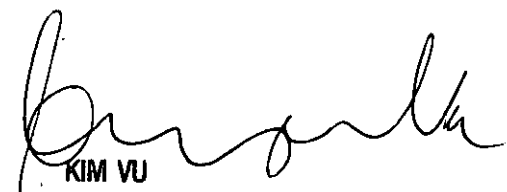
Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hung Pham whose telephone number is 703-605 4242. The examiner can normally be reached on Monday-Friday, 7:00 Am - 3:30 Pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, VU, KIM YEN can be reached on 703-305 4393. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746 7239 for regular communications and 703-746 7238 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305 3900.

Examiner: Hung Pham

Feb 27 2002


KIM VU
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100